

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MALCOLM L. GEFTER,
ZE'EV SHAKED, and
MALCOLM MORVILLE

MAILED

SEP 19 2002

Appeal No. 2001-2336
Application No. 08/300,510

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before WILLIAM F. SMITH, SCHEINER, and GRIMES, Administrative Patent Judges.
GRIMES, Administrative Patent Judge.

REMAND TO THE EXAMINER

Several issues must be addressed before the merits of the examiner's
rejection can be reached. We therefore remand this application to the examiner
for appropriate action.

1. Procedural Background

This application has been subject to extensive prosecution since the final
rejection, which has contributed to our problems in determining what claims and

issues are properly before us. The claims were finally rejected on the basis of indefiniteness (claim 133), nonenablement ("claims 133 and 103-144") and obviousness (claims 103-144). See Paper No. 21, mailed Dec. 10, 1996. After filing further arguments and a Notice of Appeal (Paper Nos. 22 and 23, filed June 10, 1997), Appellants filed an Appeal Brief (Paper No. 27, filed Dec. 12, 1997) together with an amendment to claim 133 proposing to change the term "nonimmunogenic" to "without adjuvant."

The examiner refused to enter this amendment, and also notified Appellants that their Brief was defective. See Paper No. 29, mailed March 5, 1998. Appellants filed a new Brief (Paper No. 31, filed April 6, 1998) and re-filed the same amendment that had already been denied entry (Paper No. 30, filed April 6, 1998). The examiner again refused to enter the amendment and notified Appellants that their new Brief was defective. See Paper No. 32, mailed June 17, 1998. Appellants filed a third Brief, Paper No. 33, on July 17, 1998.

On September 22, 1998, the examiner held a telephone interview with Appellants' attorneys. See Paper No. 34. In the Interview Summary Form, the examiner stated that he

contacted attorney to see how prosecution might be advanced in view of art that has recently come to the Examiner's attention. Brinner et al. which was appended to the Appeal Brief was not officially considered as it was not submitted prior to final rejection in an IDS. Brinner et al. teach Fel d I peptides IPC-1 and IPC-2 having the same sequences as those disclosed by SEQ ID NOS: 1 and 2. Attorney suggested that prosecution be focused on the invention as set forth in claim 108 directed to peptides comprising at least 20% of the T cell epitopes of an allergen. Attorney to consider cancellation of claims directed to other subject matter to simplify issues on appeal. Examiner agreed to cite and apply

Brinner et al. and Kuo with respect to the invention as disclosed in claim 108 (as it reads on the elected species Fel d I). Appellant was informed that the Appeal Brief of record did not contain a concise explanation of the invention as claimed in claim 108 and that a "Notification of Non-compliance with 37 CFR 1.192(c)[]" would be mailed.

The notification of non-compliance was mailed (Paper No. 34, mailed Sept. 24, 1998). In response, Appellants filed an amendment proposing to cancel claims 103-107, 110-113, 118, 119, and 124-127, and also making the "without adjuvant" change to claim 133 that had twice before been denied entry. See Paper No. 35, filed Oct. 26, 1998. Appellants also filed a new Appeal Brief on the same day (Paper No. 36). In the Brief, Appellants stated that they "assumed that the Amendment . . . will be entered for purpose of appeal and the claims argued herein will reflect this assumption." Page 2.

In response, the examiner filed an Examiner's Answer (Paper No. 37, mailed January 2, 1999). In the Answer, the examiner did not expressly say whether or not the amendments of Paper No. 35 would be entered. With respect to claim status and amendments, the examiner stated only that "[t]he statement of the status of the claims contained in the brief is correct," and that "[t]he appellant's [sic] statement of the status of amendments after final rejection contained in the brief is correct." Page 2. He also stated that "[t]he copy of the appealed claims contained in the Appendix to the Brief is correct." Page 4. The appendix to the most recently filed Brief contains only claims 108, 109, 114-117, 120-123, and 128-144. These statements suggest that the amendment was entered.

On the other hand, however, the rejections set out in the Examiner's Answer suggest that the amendments were not entered, and that all of claims 103-144 are pending. For example, the examiner rejected claim 133 under 35 U.S.C. § 112, first and second paragraphs, based on the "nonimmunogenic" language that Appellants proposed to change to "without adjuvant." See pages 5 and 6. He expressly noted that these rejections would be overcome "upon entry of the proposed amendment limiting the claimed compositions to those without adjuvant. This proposed claim language limitation was not entered." Page 6 (emphasis in original). In addition, the examiner applied the obviousness rejection to "[c]laims 103-144." Page 7.

The examiner's response to Appellants' arguments seems to suggest that he was relying, at least in part, on an Appeal Brief other than Paper No. 36, i.e., one of the Appeal Briefs that prompted a notice that it was defective. For example, on page 10 of the Answer, the examiner refers to Appellants as "urg[ing] that claims 104, 106, 109, 111, 113, 120, and 121 . . . are not suggested by the prior art." Likewise, on page 11, the examiner refers to arguments directed to "claims 105, 127, [and] 134-137" and to "claims 107 and 124-126." We do not find these claim groupings anywhere in Appellants' latest Appeal Brief, although they are found in the briefs filed before the proposed amendment that cancelled claims 103-107, 110-113, 118, 119, and 124-127. See, e.g., Paper No. 33, pages 16, 17, and 19.

Appellants did not file a Reply Brief to seek clarification. We also note that, for unknown reasons, the case was not received at the Board until

sometime after October 1, 2001, even though it was fully briefed in January 1999.

2. Questions raised by the record

The prosecution history summarized above gives rise to several questions that must be clarified before we can reach the merits of this appeal. The first question that arises is, which claims are pending? The examiner's Interview Summary suggests that he agreed to the cancellation of several claims in order to focus on the invention defined by claim 108. Appellants followed through on the interview by filing an amendment proposing to cancel claims 103-107, 110-113, 118, 119, and 124-127. (We note, however, that they also included the amendment to claim 133 that had already been denied entry twice.) The Examiner's Answer seems to completely ignore the proposed amendments filed with the latest Appeal Brief and, in fact, seems to ignore the latest Appeal Brief itself in preference to an earlier one that the examiner refused to answer because it was defective.

The second question that arises is, why was the Brinner reference not applied? The examiner's Interview Summary states that he contacted Appellants' attorney to discuss the Brinner reference and that, although Brinner was not "officially considered," it disclosed two peptides having the same amino acid sequence as the instant application's SEQ IDs 1 and 2. The Interview Summary also states that, apparently in connection with Appellants' agreement to cancel certain claims, the examiner "agreed to cite and apply Brinner et al. and Kuo with respect to the invention as disclosed in claim 108." Paper No. 34.

Thus, it appears that the examiner and Appellants agreed that Brinner was the closest prior art and that it should be applied to at least some of the claims. However, the Examiner's Answer does not mention a reference by Brinner. The prior art rejection is based on the same references cited in the Final Rejection.

The third question that arises is, has Appellants' amendment to claim 133 been entered? Appellants have proposed the same amendment to claim 133 three times. The examiner has acknowledged that the amendment would overcome the rejections based on 35 U.S.C. § 112 (although he asserted that it also raises new issues relating to scope and search). See the Examiner's Answer, pages 5-7. The examiner refused to enter the amendment the first two times and ignored it the last time it was proposed, while maintaining the rejections based on the limitation proposed to be changed.

3. Future proceedings in this application

On return of this application, the examiner should address the following issues.

First, indicate clearly whether or not the amendments filed October 26, 1998 have been entered. If they have not been entered, the examiner should make clear his basis for denying entry. In addition, if the amendments were not entered, and prosecution is not reopened, the examiner should indicate whether the Appeal Brief filed on October 26, 1998 is defective for failing to meet the requirements of 37 CFR § 1.192(c). We note that the arguments in the brief filed October 26, 1998 assume entry of the accompanying amendment and do not mention any of claims 103-107, 110-113, 118, 119, and 124-127. Nor do these

claims appear in the appendix to the Brief. If the Brief does not comply with 37 CFR § 1.192(c), and prosecution is not reopened, Appellants should be “notified of the reasons for noncompliance and provided with a period of one month within which to file an amended brief.” 37 CFR § 1.192(d).

Second, the examiner’s interview summary suggests that the Brinner reference is the closest prior art, or at least that it is closer than the Kuo reference applied in the rejection on appeal. If so, the proper course of action is to make a new rejection in order to apply the newly found reference. If the Brinner reference is not as relevant as suggested by the Interview Summary, the examiner should state on the record why he has decided that it is less relevant than Kuo, and why the claims are patentable over Brinner, alone or in combination with the other art of record.

We are not authorizing entry of a Supplemental Examiner's Answer. If the examiner decides that the proposed amendments should be entered and/or that a rejection based on Brinner is appropriate, reopening prosecution may be necessary. Appellants must be given a full and fair opportunity to respond to any ground of rejection in a future communication.

REMANDED

William F. Smith WILLIAM F. SMITH)
Administrative Patent Judge)
Toni R. Scheiner) BOARD OF PATENT
TONI R. SCHEINER)
Administrative Patent Judge) APPEALS AND
Eric Grimes) INTERFERENCES
ERIC GRIMES)
Administrative Patent Judge)

LAHIVE & COCKFIELD, LLP
28 STATE STREET
BOSTON, MA 02109

EG/jlb